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10/037,630

01/03/2002

J. Blake Scott

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1601 MARKET STREET
SUITE 2400
PHILADELPHIA, PA 19103-2307

EXAMINER

MARCANTONI, PAUL D

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte J. BLAKE SCOTT

Appeal 2008-4703
Application 10/037,630
Technology Center 1700

Decided: August 26, 2008

Before CHARLES F. WARREN, TERRY J. OWENS, and
LINDA M. GAUDETTE, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Applicant appeals to the Board from the decision of the Primary Examiner finally rejecting claims 1 through 20 in the Office Action mailed April 6, 2006. 35 U.S.C. §§ 6 and 134(a) (2002); 37 C.F.R. § 41.31(a) (2006).

ORDER REMANDING TO THE EXAMINER

We remand the application to the examiner for consideration and explanation of issues raised by the record. 37 C.F.R. § 41.50(a)(1) (2008);

Manual of Patent Examining Procedure (MPEP) § 1211 (8th ed., Rev. 3, August 2005).

The record shows that in the Office Communication mailed November 21, 2006, the Examiner stated “Billy R. Scott and Dallas N. Little have been added as inventors in this application.” We find that this change in inventorship is not reflected in the official electronic files of the USPTO.

The record further shows that in the Evidence Appendix to the Appeal Brief, Appellant set forth the date the Declaration under 37 C.F.R. § 1.132 of Dallas L. Little was entered into the record but did not include a copy of the declaration. App. Br. 32. Appellant further included in the Evidence Appendix a copy of a page of the *Standard Specifications for Construction of Highways, Streets and Bridges* (1993) but did not set forth the date this document was entered into the record by the Examiner. Appellant submitted argument based on this document. App. Br. 11. The Examiner considered Appellant’s argument in this respect but did not make the document of record. Supp. Ans. 5.

37 C.F.R. §§ 41.33(d)(1) and (d)(2) provide in pertinent part: “An affidavit or other evidence filed after the date of filing an appeal . . . and prior to the date of filing a brief . . . may be admitted if the examiner determines that the . . . evidence overcomes all rejections under appeal and that a showing of good and sufficient reasons why the . . . other evidence is necessary and was not earlier presented has been made,” and “[a]ll . . . other evidence filed after the date of filing an appeal . . . will not be admitted” 37 C.F.R. §41.37(c)(1)(ix) provides in pertinent part: “An appendix containing copies of any evidence submitted pursuant to § . . . 1.132 . . . or

of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief.” 37 C.F.R. §41.37(c)(2) provides in pertinent part: “A brief shall not include . . . any new or non-admitted . . . other evidence.” *See also* MPEP §§ 1205.02 and 1206, II. Affidavits or Other Evidence (8th ed., Rev. 3, August 2005).

We do not find in the record where the *Standard Specifications for Construction of Highways, Streets and Bridges* was submitted prior to filing the Appeal Brief. Accordingly, this document constitutes evidence filed after the Notice of Appeal and with the Brief, and thus is inadmissible under the above rules. Thus, Appellant’s reliance on this inadmissible evidence in arguments presented in the Appeal Brief is improper under the above rules. The Examiner should have held the Appeal Brief non-compliant on this basis, and so notified Appellant pursuant to 37 C.F.R. §41.37(c)(1)(d).

Accordingly, the Examiner is required to take appropriate action consistent with current examining practice and procedure to have the official electronic files reflect the change in inventorship, require Appellants to submit an amended brief which does not include the said document and argument based thereon, and submit an amended answer which does not consider such argument, with a view toward placing this application in condition for decision on appeal with respect to the issues presented.

This remand is *not* made for the purpose of directing the examiner to further consider the grounds of rejection. Accordingly, 37 C.F.R. § 41.50(a)(2) does not apply.

Appeal 2008-4703
Application 10/037,630

We hereby remand this application to the examiner, via the Office of a Director of the Technology Center, for appropriate action in view of the above comments.

REMANDED

tc

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